



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,091	01/16/2004	Hiroshi Kato	Q79435	5264

23373 7590 03/10/2006  
SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER
----------

GOODROW, JOHN L

ART UNIT	PAPER NUMBER
----------	--------------

1756

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/758,091

Applicant(s)

KATO ET AL.

Examiner

John L. Goodrow

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-12, 14-17, 19-24, 26-41 and 43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-12, 14-17, 19-24, 26-41 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

Art Unit: 1756

**DETAILED ACTION**


Claims 1-6, 8-12, 14-17, 19-24, 26-41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proper [6756173] in view of Hollenbaugh et al [6291121], Tachi et al [6677096], Winnik et al [5202209] and Gutman et al [6503677]. Applicants' arguments have been carefully considered but deemed not persuasive in view of the newly applied reference. Applicants' claims 1-6, 8-12, 14-17, 19, 23, 27-41 and 43 are considered as product by process claims and apparatus using the toner. Once a product is fully disclosed in the art, future claims to that same product are precluded, even if that product is claimed as made by a new process. Applicants' attention is to the Latest CAFC –Smithkline v Apotex- Product by Process. Patentability is based on the product itself. Claims 20-22, 24 and 26 are to the product itself. Proper teaches the step of externally adding surface additive particles to a toner composition. The surface additives added after classification are mixed with the classified toner particle within a high speed blender. Lists of such additives are taught in Col.6 such as silica, titanium oxide, and fatty acid metal salts. Multiple layers of surface additives become attached to the toner particle note Col7 lines 20-30. The additives are taught in more detail in the toner compositions of the secondary references. Hollenbaugh teaches both positive and negative silica with titanium oxide and fatty acid as additives to improve the charging capabilities and flowability of the toner. Tachi et al teaches size and charge of silica having both positive and negative charges. Winnik et al teaches additives having both positive and negative silica note Col. 2 . Gutman teaches both positive and negative additives and zinc stearate and titania Col. 6 – Col. 8 to toners that exhibit high stable triboelectric charging characteristics. It would be obvious to one of ordinary skill in the art at the time of applicants' invention with a reasonable expectation of success to use the well known surface additives on the surface of the known toners to control both the chargeability and flowability properties of the toners.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Goodrow whose telephone number is 571-272-1384. The examiner can normally be reached on Monday -Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1756

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John L. Goodrow  
Primary Examiner  
Art Unit 1756

\*\*\*